

REMARKS

The Specification has been objected for failing to provide the proper antecedent basis for the claimed subject matter. The Examiner states that claim 13 discloses a method to prepare the metalworking fluid involving a general ingredients list, however, the instant specification only discloses the method in the examples, which involve specific components.

Claim 1 and Claims 13-33 have been rejected under 35 U.S.C. §112, first paragraph, for failure to provide a written description of the invention.

The Examiner's objection and rejection are respectfully traversed.

Beginning on page 6 of the specification, several examples of each of the components is specified. For example, the emulsifier is listed as a alkylate sodium sulfonate, sodium carboxylate, sodium oleate, Triethalonoamine oleate, Diethalonoamine oleate or Dodecyl Toluene sodium sulfonate or mixtures thereof. As one continues in the specification, examples of each of the components are listed. Thus, while claim 13 generally lists each of the components used in the process, the remaining claims, specifically claims 14-33, further define those components as defined in the specification.

There is no requirement that every adhesive be listed and there are enough adhesives specified that one skilled in the art could make the composition.

Upon reviewing U.S. Patent No. 4,765,917 (Otaki et al.) which the Examiner has cited, the independent claim includes a water dispersible organic thickening agent, extreme pressure additive, a biocidal agent, and a performance enhancing material. The remaining claims further define these components. There is no specific list in the independent claim, but the generic terms are included in the claim. Additionally, one skilled in the art would understand

the claim and would have some knowledge as to which types, for example, of emulsifiers would work in a metalworking fluid. The specification and claims further define the emulsifiers that the inventors have utilized in their invention. The Applicants' specification and claims follow a similar pattern in its set-up.

In the subject application, claim 1 is clear and further explained in subsequent claims 2-33. The claims are supported by the specification and the examples. It is not essential that independent claims contain a list of all of the specified compounds as evidenced in various granted U.S. patents, including Otaki'971.

In the subject application there is no need for undue experimentation as examples of each component are given in the application. Additionally, there is no requirement that an example cover every combination of proposed components, this would be unfair and overburdensome to the inventors. If an application is directed to a material having five or six different components and each of those components has been described as five or six different items, it is not necessary to show examples for each and every one of those combinations. One skilled in the art has an understanding of previous metalworking fluids, and can practice the invention. Thus, the Applicant's request that the Examiner's objection to the specification and the rejection of claims 1 and 13-33 under 35 U.S.C. §112, first paragraph, be withdrawn.

Claims 1, 2, 11 and 31 have been objected to due to informalities.

The claims have been amended to obviate the Examiner's objection.

Claims 1-12 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Anantaneni, U.S. Patent No. 6,630,430, in view of Boffa, U.S. Patent No. 5,804,537, Tanaka, U.S. Patent No. 6,245,725 B1, Camenzind, U.S. Patent No. 7,026,438 B2, Van

Dam, U.S. Patent No. 6,784,142 B2, Matsushita, U.S. Patent No. 5,741,763, Zoch, U.S. Patent No. 3,902,868, and Otaki, U.S. Patent No. 4,765,917.

The Examiner's rejection is respectfully traversed.

In the cited prior art, there is no teachings or disclosure of using a petrochemical waste, specifically, heavy alkyl benzene. Also, it has not been known how to use the heavy alkyl benzene as a metalworking fluid. This was achieved only after spending many long hours completing R&D work and testing various combinations of components.

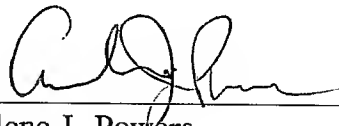
The Examiner has cited eight different references, each one being cited for teaching the use of one component. There is no teaching or disclosure to combine the teachings and components nor is there any suggestion that such a combination would work. A *prima facie* case of obviousness exists when the prior art provides motivation to make the claimed invention, and there must be some suggestion to do so. A retrospective view of inherency cannot serve as a substitute for actual teaching. Thus, the Applicants' request that the Examiner withdraw the 35 U.S.C. §103(a) rejection.

In view of the foregoing, the Applicants contend that the amended claims and the claims dependent there from are in proper form. Applicants also respectfully contend that the teachings of Anantaneni'430, in view of Boffa'537, Tanaka'725, Camenzind'438, Van Dam'142, Matsushita'763, Zoch'868, and Otaki'917 do not establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Thus, claims 1-33 are considered to be patently distinguishable over the prior art of record and should be allowed.

The application is now considered to be in condition for allowance, and an early indication of same is earnestly solicited.

The Commissioner is authorized to charge Deposit Order Account No. 19-0079 for any fees that may be required.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Arlene J. Powers', is written over a horizontal line.

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